



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/007,266	12/03/2001	James Conlow	1980.001.US	2588
23661 7590 11/28/2007 BEESON SKINNER BEVERLY LLP ONE KAISER PLAZA, SUITE 750 OAKLAND, CA 94612			EXAMINER GREIMEL, JOCELYN	
			ART UNIT 3693	PAPER NUMBER
			MAIL DATE 11/28/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.		Applicant(s)	
	10/007,266		CONLOW, JAMES	
	Examiner		Art Unit	
	Jocelyn Greimel		3693	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 September 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11, 13, 15-17, 27, 31-47, 49-87 and 89-91 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 13, 15-17, 27, 31-47, 49-87 and 89-91 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This communication is in response to Applicant's Amendments and Remarks filed 18 September 2007.

Status of Claims

Claims 1-2, 5-13, 15-28, 30-39, 41, 47-51, 53-56, 58, 60-65, 70-75, 78, 80-89 and 91-94 are currently pending. Claims 92-94 are newly added claims. Claims 3, 4, 14, 29, 40, 42-46, 52, 57, 59, 66-69, 76-77, 79 and 90 have been cancelled. Claims 1, 48 and 88 are independent claims. Applicant is requested to confirm the status of claims as it does not match the statement included in the Amendments filed 30 July 2007 (which contains the substantive Arguments).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. **Claims 1-2, 5-13, 15-28, 30-39, 41, 47-51, 53-56, 58, 60-65, 70-75, 78, 80-89 and 91-94 are rejected under 35 U.S.C. 102(b) as being anticipated by Crooks et**

al. (US Patent No. 5,943,656). In reference to claims 1, 48 and 88, Crooks discloses a method, system and medium for direct presentment and payment of bills, comprising:

- a. One or more memories for storing a list of tasks, each task in said list of tasks adding value to a defined business project, each task in said list of tasks provided by one of the one or more billing entities (col. 2, line 60 – col. 4, line 18);
- b. at least one paying entity node associated with one of the at least one paying entities, at least one billing entity node associated with one of the one or more billing entities (col. 4, line 4 – line 18);
- c. one or more network interfaces for sending and receiving data to and from entity nodes and paying said paying and billing entity nodes, and one or more processors in communication with said one or more memories and with said one or more network interfaces, each of the billing entities contractually obligated to perform at least one task of said list of tasks for one of the at least one paying entities (col. 4, line 3 – col. 5, line 12);
- d. wherein, when said one or more network interfaces receives billing data for a billing entity a request from one of said billing entity nodes for payment to one of the one or more billing entities for performance of one or more tasks of said list of tasks, said one or more processors prepares a bill for said the billing entity based on said billing data, said bill for transmission to said paying entity node requesting payment by the at least

one paying entity to the billing entity for said one or more tasks (col. 4, line 3 – col. 5, line 12).

2. **In reference to Applicant's dependent claims, claims 2, 5-13, 15-28, 30-39, 41, 47, 49-51, 53-56, 58, 60-65, 70-75, 78, 80-87, 89 and 91-94, Crooks discloses a method, system and medium for direct presentment and payment of bills, comprising:** storing project identification information, billing and paying identification information (col. 2, line 60 – col. 3, line 21; col. 4, line 4+);
3. project is a construction project (col. 4, line 4+);
4. paying entity is a financial institution (col. 4, line 4+);
5. remittance instructions to the paying node (col. 4, line 4+);
6. storing amounts owed and paid (col. 2, line 60 – col. 3, line 21; col. 4, line 4+);
7. billing task request verification (col. 4, line 4 – col. 5, line 67);
8. calculating retention amounts (col. 4, line 4+);
9. only one billing entity provides task (col. 4, line 4+);
10. bill includes only entities tasks (col. 5, line 1+);
11. storing costs (col. 2, line 60 - col. 3, line 20);
12. identifying duplicate tasks (col. 5, line 40+);
13. comparing billed cost to stored cost (col. 5, line 40+);
14. matching billed and stored costs (col. 5, line 40+);
15. remittance instructions transmitted to paying node (col. 4, line 4+);

16. printing a check to pay the bill (col. 6, line 17+);
17. instructing a bank to pay the bill (col. 6, line 17+);
18. bills are authorized and status is checked in project (col. 5, line 40+);
19. bills are adjusted by authorizing agent (col. 5, line 40+);
20. bill created after approval by authorizing agent (col. 5, line 40+);
21. authorizing agent approves tasks were done (col. 5, line 40+);
22. authorizing requests are created for authorizing agent (col. 5, line 40+);
23. lists of tasks are identified for the paying entity (col. 5, line 1+);
24. tasks that have been billed for are identified (col. 4, line 4+);
25. tasks are identified by the billing entities (col. 4, line 4+);
26. discount amounts are calculated (col. 4, line 4 – col. 5, line 67);
27. fee amounts are applied to the bill (col. 4, line 4 – col. 5, line 67).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 31-33 and 92-94 with their related claims are rejected under 35 U.S.C. 103(a) as being unpatentable over Crooks in view of Official Notice. The Examiner takes Official Notice that the following are old and well-known in the bill processing field. As noted in Crooks, bills can be audited and "subjected to remedial processing measures, either manually or electronically, to ensure that billing information is accurate." The following dependent claims are aspects of billing that are old and well-known in the art to add, identify and include with a billing statement:

28. claims release for mechanics liens are created
29. an unconditional claims release or final release is created
30. billing report identified mechanics liens that are released
31. bill includes definition of full completion or partial completion;
32. bill includes a progress billing report.

It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to have modified the method, system and medium for direct presentment and payment of bills of Crooks to include the above mentioned items, as it would make the billing statements more complete and thereby increasing company revenue and client satisfaction.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jocelyn Greimel whose telephone number is (571) 272-3734. The examiner can normally be reached on Monday - Friday 8:30 AM - 4:30 PM EST.

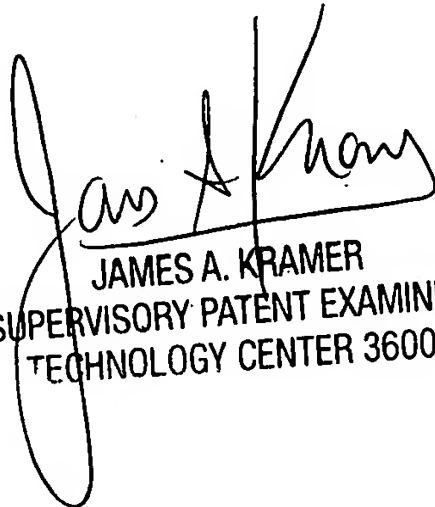
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on (571) 272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Application/Control Number:
10/007,266
Art Unit: 3693

Page 8

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jocelyn Greimel
Examiner, Art Unit 3693
November 21, 2007


JAMES A. KRAMER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600
11/26/07